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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,351	04/17/2001	Richard F. Rudolph	IP6078	8882
7590	07/20/2005		EXAMINER	
INTERNATIONAL PAPER COMPANY 1422 LONG MEADOW ROAD TUXEDO, NY 10987			YANG, CLARA I	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/837,351	RUDOLPH ET AL.
	Examiner Clara Yang	Art Unit 2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 April 2001.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 17 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claims 9 and 10 are objected to because of the following informalities:
  - Claim 9: Change the last limitation, which is not in idiomatic English, to "interrogating said RFID tag and coupling to an Internet connection to provide unique historical information relating to the specific container and its product contents."
  - Claim 10: Replace the period after "MSDS" with a comma.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. The term "wide array" in claim 6 is a relative term that renders the claim indefinite. The term "wide array" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Consequently, the limitation "wide array of products" is rendered indefinite. The limitation is understood to call for the MSDS information of a manufacturer's products.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawley et al. (US 2001/0021950).

Referring to claim 1, Hawley's system, as shown in Fig. 1, comprises: (a) a plurality of tokens 20, which are prescription drug containers (i.e., product containers) (see Sections [0011], [0018], and [0024]); (b) a radio frequency identification (RFID) tag associated with each token 20 (herein after referred to as "container 20"), wherein each RFID tag has data memory means for storing at least a unique identification code of the tag's microchip, the uniform resource locator (URL) of the drug manufacturer's home page (i.e., one remote storage access code for accessing additional data associated with container 20 and stored outside of the RFID tag's memory means), and a data item identifying the particular drug (see Sections [0018], [0019], and [0025]); and (c) reader 15 and computer 10 providing means for retrieving the unique identification code and URL from the RFID tag's memory means (see Sections [0024]-[0026]).

Regarding claim 2, Hawley's reader 15 and computer 10 form an interrogator that accesses the unique identification code, manufacturer's URL, and drug identifier from each RFID tag's memory in order to retrieve information uniquely associated with container 20 (see Sections [0018] and [0033]).

Regarding claim 3, a material safety data sheet (MSDS) is a form containing data regarding the properties of a particular substance (as defined by Wikipedia). Consequently, the

traditional paper "package insert" that is found with prescription drug containers is a material safety data sheet (see Section [0018]). Per Hawley, each container 20 is associated with information that includes the MSDS for the drug (see Section [0018]).

Regarding claim 4, Hawley discloses that the MSDS is stored on the drug manufacturer's web site and is the most up-to-date (see Section [0018]); thus the MSDS is stored remotely from container 20 and must be updated.

Regarding claim 5, Hawley's interrogator is coupled to the updated MSDS information via network 25, which is an Internet connection (see Sections [0018] and [0026]).

Regarding claim 6, Hawley's interrogator is coupled by network 25 to a server (i.e., a data processor) that is hosting a drug manufacturer's web site, which includes the MSDS of its products (see Sections [0018], [0026], and [0027]).

Regarding claims 7 and 8, Hawley's interrogator has access to historical information, such as the manufacturer's identity, associated with container 20 as identified by the unique identification code and manufacturer's URL stored in the tag's memory (see Sections [0018], [0025], [0032], and [0033]).

Referring to claims 9 and 10, Hawley's method comprises: (a) placing an RFID tag on each product container 20, wherein each RFID tag has a unique identification code (see Sections [0011], [0018], and [0025]); (b) storing the drug manufacturer's URL code in each RFID tag's memory (see Sections [0018] and [0019]); (c) storing historical information, such as the drug identifier (i.e., product number, as called for in claim 10), in each RFID tag's memory (see Sections [0018] and [0019]); and (d) interrogating container 20's RFID tag and providing an Internet connection to obtain unique historical information, such as a drug's most up-to-date

online "package insert" information (i.e., MSDS) and interaction information with other drugs, relating to a specific container 20 and its product contents (see Section [0018]).

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Klein (US 6,259,367) teaches affixing an RFID label to a product, wherein the RFID label includes a unique identification number and the vendor's URL.
- Muirhead (US 6,327,576) teaches affixing an RFID tag to a hazardous material container, wherein the RFID stores information (e.g., storage instructions, clean up information, work injury information, etc.) that is traditionally contained on an MSDS.
- Ogasawara (US 6,327,576) teaches affixing RFID tags on products, wherein each RFID tag stores the universal product code (UPC) or stock keeping unit (SKU) code of the product to which the RFID tag is affixed. An interrogator then obtains the product's information, which resides on a web server, when the UPC or SKU is read from the RFID tag.
- Shaw (US 6,563,417) teaches attaching RFID tags to a product and using the RFID tags to obtain unique data of the product.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY

13 July 2005

